

Remarks:

Applicants wish to thank the Examiner for marking the final Office Action to acknowledge, both, the claim to §119 priority and receipt of the certified copy, as requested.

Claims 1-42 are pending, with claim 1 being amended hereby, and with claims 2-5, 14-20, 22-25, and 27-36 withdrawn as being non-elected pursuant to a requirement for election of species.

Claim 1 is amended to recite

(ii) one or more hydrophilic polymer ~~end~~ blocks, including a hydrophilic end block, compatible with the hydrogel-forming hydrophilic homopolymers or heteropolymers,

as described in the instant specification (page 10, second complete paragraph).

Applicants maintain their election with traverse set forth in the response filed October 15, 2009, for the reasons provided of record.

Claim 1 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter, i.e., the feature "one or more hydrophilic polymer end blocks." Since the feature is not found in present claim 1, the rejection is rendered moot. Withdrawal of the rejection under §112, ¶1, is in order.

Claims 1, 6-13, 21, and 26 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 98/48858 (WO '858) in view of CA 02426251 (CA'251), as allegedly evident by the article by Wang. Reconsideration is requested.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 180 USPQ 580 (CCPA 1974), and the "Examiner bears [both] the initial burden...of presenting a *prima facie* case of unpatentability" and

"the ultimate burden of persuasion on the issue." *In re Oetiker*, 24 USPQ 1443, 1444 and 1447 (Fed. Cir. 1992) . "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

The §103(a) rejection is fatally flawed (i.e., clearly erroneous) for at least two reasons. First, the PTO finds (Final Action, page 11) (emphasis added)

all the elements of the [claimed] composition are taught by the combination of references [including] CA'451 teaches amphiphilic block copolymers comprising both hydrophobic and hydrophilic blocks...as the present invention.

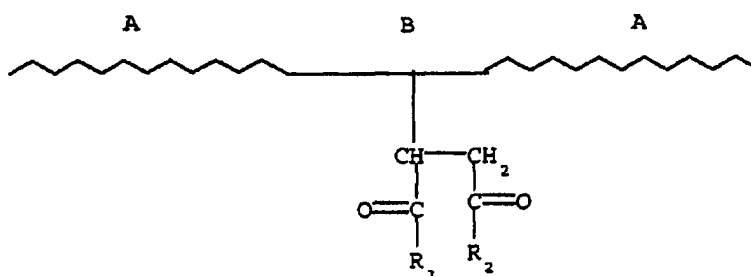
Contrary to the aforesaid finding, "all the elements" of the presently claimed composition are not "taught by the combination of references." None of the cited references, taken alone or in combination, teaches or suggests the hydrophilic-end-block feature/limitation—of the one or more amphiphilic block-copolymers—of the rejected (and present) claims.

The PTO erroneously relies on CA'251 to meet the "one or more amphiphilic block-copolymers" feature of the rejected (and present) claims; specifically, the PTO finds an amphiphilic block copolymer in CA '251 (page 2, lines 25-34, and page 8, lines 23-28)—that "comprises polystyrene blocks and polyethylene glycol blocks" (Final Action, page 7)—allegedly meets the "one

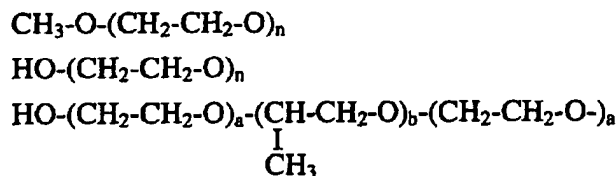
or more amphiphilic block- copolymers" feature of the rejected (and present) claims. With all due respect, the PTO finding is clearly erroneous.

CA '251 is limited to a very specific triblock copolymer, which contains only blocks of styrene polymer and ethylene/butylene polymer. As taught in CA '251 (page 2, line 29, through page 3, line 11) (emphasis added):

according to a first feature, the present patent application aims to cover amphiphilic block copolymers of the ABA type containing two polystyrene thermoplastic end blocks A and one elastomeric mid block B, wherein this mid block B is a poly(ethylene/butylene) block containing grafted hydrophilic groups, it being possible for said amphiphilic copolymer ABA to be represented schematically by the following structure:



in which R_1 and R_2 , which are identical or different, are hydrophilic groups with an average molecular weight below 10,000, selected from the following groups:



in which n , a and b are integers.

As readily understood from the aforesaid description in the reference, the only "end blocks" of the amphiphilic copolymer described in CA'251 are hydrophobic "polystyrene" blocks. The only

hydrophilic block constitutes a midblock, i.e., the "poly(ethylene/butylene) block containing grafted hydrophilic groups" midblock "B"—sandwiched between two hydrophobic end blocks "A"—in the "ABA" amphiphilic block copolymer. Accordingly, the amphiphilic copolymer described in CA'251 contains no hydrophilic end blocks.

As opposed to the amphiphilic block copolymer disclosed in CA '251, the "one or more amphiphilic block-copolymers" recited in the present claims contain (as explained above) a hydrophilic polymer end block. Accordingly, the PTO erroneously ignores the specific hydrophilic-end-block limitation of the rejected (and present) claims—in finding it met by the CA'251 amphiphilic block copolymer that does not contain a hydrophilic end block—rendering the rejection untenable. *Murphy*, 217 USPQ at 481 ("it is error to ignore specific limitations distinguishing over the reference").

Looking at it another way, the PTO neglects specific teachings of CA '251 that are indispensable to correctly interpret (i.e., characterize) the amphiphilic block copolymer disclosed in the reference, which neglected teachings (as explained above) show the amphiphilic block copolymer that "comprises polystyrene blocks and polyethylene glycol blocks" contains only hydrophobic end blocks. The amphiphilic block copolymer recited in the rejected (and present) claims is not found in CA '251—at page 2, lines 25-34, or page 8, lines 23-28, or any other page of the cited reference. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other

parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

As admitted in the statement of rejection, WO '858 does not support the "one or more amphiphilic block copolymers" limitation of the present claims. Accordingly, since "the cited references do not support each limitation of [the] claim[s]," the §103(a) rejection—as applied against either the rejected claims or the present claims—is "inadequate on its face." *Thrift*, 63 USPQ2d at 2008. All limitations of the claims must be taught or suggested by the cited prior art in order to establish *prima facie* obviousness of the presently claimed invention. *Royka, supra*.

Secondly—besides failing to satisfy the *all elements* rule (*Royka, supra*)—the PTO erroneously requires (Final Action, page 11) that the amphiphilic block copolymer having hydrophilic-end-block feature (i.e., "having both hydrophobic and end hydrophilic [*sic*] blocks" (emphasis added)) must be "superior" and applicants must "show unexpected results obtained from having end block hydrophilic polymer rather than mid block." Requiring the claimed invention to be "superior" to the prior art is legally erroneous and, therefore, renders the rejection untenable. *Ryco Inc. v. Ag-Bag Corp.*, 8 USPQ2d 1323, 1328 (Fed. Cir. 1988) ("Nothing in the patent statute requires that an invention be superior to the prior art to be patentable").

Moreover, requiring that applicants prove nonobviousness—by providing "unexpected results obtained from having end block hydrophilic polymer rather than mid block"—renders the rejection untenable because it erroneously shifts the burden of proof from the PTO to applicants on the issue of obviousness. In accordance with §103(a), the initial and continuing burden rests with the PTO

to prove obviousness, rather than resting with applicants to prove nonobviousness, allegations to the contrary in the statement of rejection notwithstanding. *Oetiker*, 24 USPQ at 1444 (the "Examiner bears [both] the initial burden...of presenting a *prima facie* case of unpatentability" and "the ultimate burden of persuasion on the issue"). *Royka*, *supra* (presenting a *prima facie* case of obviousness requires a showing—by the PTO—that all the claim limitations are taught or suggested by the prior art).

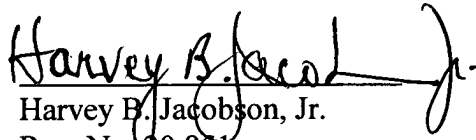
For the foregoing reasons, the rejection under §103(a) is overcome, and withdrawal of the rejection is in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By


Harvey B. Jacobson, Jr.
Reg. No. 20,851

400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350 ²⁴
Date: September 28, 2010
HBJ:WEP/mwb

H:\wep&secretary\2010\September\P71166US0 afamd.wpd